



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/815,621

04/02/2004

Kia Silverbrook

HYC001US

9577

24011 7590 03/18/2008
SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

MOSSER, ROBERT E

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

03/18/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/815,621	Applicant(s) SILVERBROOK ET AL.	
	Examiner ROBERT MOSSER	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-31, 33, 35-37, 39 is/are rejected.
- 7) ☒ Claim(s) 32,34 and 38 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/7/04, 10/18/04, 2/12/07</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statements submitted 2/12/2007, 10/18/2004, and 10/07/2004 have been considered. A copy of each respective statement including the Examiner's notation is attached for the Applicant's records.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim **29** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A mere arrangement of printed matter, though seemingly a "manufacture," is rejected as not being within the statutory classes. See *in re Miller*, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969); *EX part Gwin*, 112 USPQ 439 (Bd. App. 1955); and *In re Jones*, 373 f.2d 1007, 153 USPQ 77 (CCPA 1967). In the present application, the claimed printed matter se-forth a mere arrangement of printed matter that is not functionally related to the substrate and, therefore, does not distinguish the invention from prior art in terms of patentability. Although printed matter must be considered, in this situation, it is not entitled patentable weight. The printed matter claimed herein conveys no meaningful information in regard to the substrate, which they are arranged on and do not require any size relationship of the substrate, and do not require any particular substrate to effectively convey the information. Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is

no reason to give patentable weight to the content of the printed matter which, by itself, is no-statutory subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims **1-6, 24, 29, 35, and 39** are rejected under 35 U.S.C. 102(b) as being anticipated by Seidman (US 5,080,364).

Claims **1, 24, 29, 35, and 39**: Seidman teaches competition system including the use of machine readable coded data printed on the label of a product. The system of Seidman further teaches interaction data from a barcode reading device indicating the reading of a barcode and affecting the entry into a competition responsive thereto (Figure 1, 2; Col 2:26-32, 2:61-63). Seidman further includes the registration of information with a central data base (Elm 22, 24 Figures 1-2)

Claim **2**: Seidman further teaches the inclusion of human readable information related to the competition (Figure 2; Elm 30, 40).

Claims **3-6**: Seidman teaches the use of coded data identifying the label, a unique product code UPC (Figure 2). Wherein bar-coded data is understood to be substantially invisible to a human because though a barcode may be recognizable as a series of the lines the data contained therein is not readily observable by a human.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **7-23**, **25-28**, **29-31**, **33**, and **36-37** are rejected under 35 U.S.C. 103(a) as being unpatentable over Seidman (US 5,080,364) in view of Silverbrook et al (US 6,457,883).

Claim **7**, **20**, and **29-30**: Seidman teaches the entry of additional information by the player/user is silent regarding the utilization of digital ink to capture additional registration information however, in a related reward scheme Silverbrook teaches the utilization of a digital ink scheme for the capture of additional information (*Silverbrook* Col 21:14-26, 21:41-3:45). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the teachings of Silverbrook into the invention of Seidman because such a combination would represent the mere

combination of known reward systems through conventional means that would yield expected and predictable results.

Claim **8-12, 21-22**, and **25**: In addition to the above, Silverbrook teaches the incorporation of data identifying the form and determine the relative position/movement of sensing device relative to the form based on coded data present on the form to enter information through writing (*Silverbrook Fig 1, 7*).

Claims **13-16, 26-28**, and **33**: In addition to the above, Silverbrook teaches the implementation of addition form fields for the user to provide information on a request form including a submit button and allowing the capture of signatures (*Silverbrook Figure 1; Col 21:14-26*).

Claims **17-19**: In addition to the above, Seidman teaches the claimed features as address in the rejection of at least claims 3-6 as presented above.

Claim **23**: In addition to the above, Seidman teaches the claimed features as address in the rejection of at least claims 2 as presented above.

Claim **31**: In addition to the above, Silverbrook teaches the inclusion of a application alias ID (*Silverbrook Elm 65; Col 37:22-30*).

Claims **36-37**: The claim language directed to the redemption or utilization of a coupon is understood as equivalent to the previously described ticket or entry of the prior art as applied above.

Allowable Subject Matter

Claims **32**, **34**, and **38** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT MOSSER whose telephone number is (571)272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert E Pezzuto/
Supervisory Patent Examiner, Art Unit 3714

/R. M./
Examiner, Art Unit 3714
March 8th, 2008